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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FLEMMING BOEGELUND and DEBRA A. KIPPING

Appeal 2007-3356
Application 09/998,043
Technology Center 2600

Decided: February 28, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,
and ANITA PELLMAN GROSS, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-19. Claims 20-30 have been canceled.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to the translation of text on an original presentation slide from a first language to a second language. Text information, as well as addressing information which indicates the location of the text on the slide, is extracted from the slide and inserted into an auxiliary file for the translation procedure. After translation, the translated text information is written onto the copy of the original presentation slide at the locations of the originally read text. (Specification 6-7).

Claim 1 is illustrative of the invention and reads as follows:

1. A computer implemented method for translating text on an original slide presentation from a first language to a second language comprising the steps of:

creating a text file, the text file having a format that can enable text be translated from one language to a second language using conventional file translation techniques;

inserting text from an original presentation slide into the created text file;

¹ The cancellation of claims 20-30, indicated by Appellants at page 2 of the Brief, has been verified by the Examiner in a communication mailed March 15, 2007.

translating the text inserted into the text file from a first language to a second language; and

writing the translated text onto the original presentation slide, in the location of the original text that was translated, using information contained in the original presentation slide.

The Examiner relies on the following prior art references to show unpatentability:²

| | | |
|-----------|--------------|---------------|
| Rosenbaum | US 5,404,435 | Apr. 4, 1995 |
| Chou | US 5,583,761 | Dec. 10, 1996 |

Claims 1-6 and 10-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chou in view of the admitted prior art.

Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chou in view of the admitted prior art and further in view of Rosenbaum.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

² In addition, the Examiner relies upon Appellants' admissions as to the prior art at page 1, lines 19-27 of the Specification.

(i) Under 35 U.S.C § 103(a), with respect to appealed claims 1-6 and 10-19, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Chou and the admitted prior art to render the claimed invention unpatentable?

(ii) Under 35 U.S.C § 103(a), with respect to appealed claims 7-9, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Chou and the admitted prior art by adding the teachings of Rosenbaum to render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127

S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1 and 15 based on the combination of Chou and the admitted prior art, Appellants' arguments in response assert a failure to set forth a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art. Appellants' arguments (App. Br. 5-7; Reply Br. 2) focus on the contention that, in contrast to their invention which is a "batch" process which performs language translations of text on original existing completed slides, the system of Chou is directed to language translation of text in a real-time "on-the-fly" parallel creation and translation process.

It is our view, however, that Appellants' arguments are not commensurate with the scope of the claims. As pointed out by the Examiner (Ans. 18-19), there is no language in independent claims 1 and 15 which requires that the claimed language translation method be a "batch" process involving translations of text on previously created slides. Conversely, we would add, there is nothing in claims 1 and 15 which would preclude the real-time language translation features disclosed by Chou. It is our opinion that Appellant's arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

We further find no error, and there are no convincing arguments to the contrary from Appellants, in the Examiner's finding of obviousness (Ans. 4, 5, and 19) with respect to the proposed combination of Chou and the admitted prior art. In our view, the skilled artisan would have recognized that the presentation program language translation teachings of Chou would have obvious applicability to the slide presentation creation development programs of the admitted prior art.³

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness based on the combination of Chou and the admitted prior art which has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1 and 15, as well as dependent claims 3-6, 10-14, and 16-19 not separately argued by Appellants, is sustained.

We also sustain the Examiner's obviousness rejection of separately argued dependent claim 2 based on the combination of Chou and the admitted prior art. We find no error in the Examiner's finding (Ans. 5) that Chou's use of addressing information to locate the coordinate position of extracted original text satisfies the claimed requirement of using location addressing information "related to the configuration of the objects."

Appellants' arguments (Reply Br. 3) to the contrary notwithstanding, there is no requirement in the language of claim 2 that the claimed objects be non-

³ We make the observation that Appellants' arguments (App. Br. 7) impliedly recognize the appropriateness of the Examiner's proposed combination by characterizing the language translation system of Chou as being directed to the creation of a "file/slide."

text objects or, conversely, any language that would preclude Chou's text location configuration feature from being considered an object configuration.

Turning to a consideration of the Examiner's 35 U.S.C § 103(a) rejection of dependent claims 7-9 in which the proposed combination of Chou and the admitted prior art is modified by the addition of Rosenbaum, we sustain this rejection as well. Appellants' arguments (App. Br. 7; Reply Br. 3) initially focus on the contention that Rosenbaum lacks any disclosure of a language translation feature as presently claimed. We find such contention to be unpersuasive since the Examiner has relied upon Chou, not Rosenbaum, for a teaching of the language translation of text in a presentation program. It is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of Chou, the admitted prior art, and Rosenbaum. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F. 2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1096 (Fed. Cir. 1986).

We further find to be without merit Appellants' argument (App. Br. 8; Reply Br. 3) that Rosenbaum is inapposite to Chou since Rosenbaum is concerned with identifying and handling non-text objects in a document while Chou is directed to the translation of text objects and does not discuss non-text objects. To whatever extent the disclosure of Rosenbaum may be "focused" on the identification and retrieval of non-text objects as argued by

Appellants, we find, as did the Examiner, that Rosenbaum provides an unambiguous disclosure of the identifying and retrieval of text objects as well. For example, in analyzing the mixed text and non-text object document illustrated in Rosenbaum's Figure 2, Rosenbaum identifies and retrieves text objects (step 1208, col. 15, ll. 57-58), and then applies a key word extracting algorithm to the text objects (step 1210, col. 15, l. 64).

We also find no persuasive arguments from Appellants which convince us of any error in the Examiner's articulated line of reasoning (Ans. 16, 19, and 20) which establishes a proper basis for the proposed addition of Rosenbaum to the combination of Chou and the admitted prior art. As recognized by the Examiner, Chou's disclosed translation system requires a user to manually select text items that are in need of translation. (Chou, col. 3, ll. 12-15, col. 8, ll. 43-44, and col. 9, ll. 1-3). We agree with the Examiner's finding, however, that a skilled artisan would have recognized and appreciated that the ability to automatically recognize and extract text information from a mixed text object as taught by Rosenbaum would have served as an obvious enhancement to the combined system of Chou and the admitted prior art.

CONCLUSION

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-19 is affirmed.

Appeal 2007-3356
Application 09/998,043

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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